

Appln. No. 10/821,434
Amendment dated May 1, 2006
Regarding Office Action dated January 30, 2006
Docket No. 7463-37 (CE11334JI017)

REMARKS/ARGUMENTS

These remarks are offered in response to the Office Action of January 30, 2006, (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

In paragraph 2 claims 1-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/092326 to Stern-Berkowitz et al (hereinafter Stern-Berkowitz). Applicants respectfully disagree that the reference teaches every feature recited in the claims. Applicants, however, further respectfully submit that the issue is moot because Applicants' invention predates Stern-Berkowitz.

Applicants respectfully assert that they conceived of their invention and actively pursued its reduction to practice from a time prior to the March 27, 2003, effective date of Stern-Berkowitz. Applicants thus respectfully maintain that Stern-Berkowitz can not be applied against Applicants' invention.

In support of their assertion, Applicants herewith submit the attached Declaration under 37 C.F.R. § 1.131. Applicant's Declaration is submitted along with evidence of activity on specific dates establishing conception of their invention and continuing diligence to a reduction to practice from a time prior to the effective date of Stern-Berkowitz.

The Declarations are accompanied by a copy of the Applicants' Innovation Disclosure No. CE11334JI017 (18804) (Disclosure) entitled "Early Rejection of Neighbor/Serving Cells as Good Serving Cell Candidates by Loading Monitoring while Measuring." The Disclosure was submitted as a disclosure on March 11, 2003, to a patent committee having individuals who regularly review patent disclosures for Motorola including In-House Patent Counsel. The Disclosure demonstrates proof of conception for the claimed subject matter of the Applicants' invention at least as early as March 11, 2003, which predates the March 27, 2003 effective date of Stern-Berkowitz.

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The Disclosure is a Motorola Innovation Disclosure form. It is a standardized document utilized by Motorola inventors upon their conception of an invention. Motorola has established internal procedures governing the use of the confidential disclosure forms. The procedures preclude substantive modifications to a disclosure form subsequent to its submission to an Motorola patent committee having a Motorola Attorney/Patent Professional. According to Motorola's established internal procedures, if any changes and/or additions are made to the disclosure, the changes and/or modification must be appended as an attachment to the Motorola Innovation Disclosure form together with the date the attachment was added.

The present application, including each claim, was prepared based upon Applicants' Disclosure. Moreover, according to Motorola's established procedures governing the use of such disclosures, the inventor reviewed the application prior to its submission to the U.S. Patent and Trademark Office to ensure that the claims and material contained therein were fully supported by the Disclosure.

The Disclosure provided the basis of each of the claims in the application. The Disclosure explicitly describes Applicants' efficient method of monitoring neighboring cells in a communication system and the corresponding methods. The methods described include, for example, choosing the right neighbor as a potential serving cell based on services that it provides, the total loading of each service supported in addition to SQE generates more channel capacity, more battery life, better user experience, and a better balance of over-the-air resources. (See, especially, pages 4 and 5 of the Innovation Disclosure form.)

Applicants exercised due diligence from prior to the effective date of Stern-Berkowitz to the date the present application was filed. With respect to Applicants' diligence it is to be noted that, as set forth in the Declaration, once an Motorola disclosure form is completed, the disclosure is reviewed by an internal Patent Committee consisting of Technical Reviewers and a Motorola In-House counsel within Motorola to determine whether to prepare an application based upon the submitted disclosure. Upon the Patent Committee reaching a decision to prepare an application, outside counsel is selected to prepare the application, and instructions in this regard, together with the Motorola invention disclosure form, are conveyed to the outside counsel. Outside counsel prepares a draft of the application that is reviewed by each inventor.

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The inventors (or inventor in this instance), according to this standard procedure, must be satisfied that the application sufficiently details the inventive concepts described in the Disclosure.

Motorola assigned the application to outside counsel on January 20, 2004, and outside counsel drafted the present application. The draft application prepared by outside counsel was reviewed by the inventor, with whose input the application was finalized in its submitted form. This activity of reviewing a patent application is consistent with those exemplary activities noted as satisfying the legal requirements for a showing of diligence. *See, e.g.,* MPEP 715.07(a). Evidence of these activities is presented in Composite Exhibit "A," attached hereto:

1. Innovation Disclosure form showing activity from March 11, 2003 to January 20, 2004 including submission of Disclosure by the inventor, review dates by Technical Reviewers, and a review date by Motorola Attorney.
2. Correspondence from Motorola to outside counsel on January 20, 2004, instructing outside counsel to prepare and file Application;
3. Application was diligently filed within three months of receipt of disclosure by outside counsel on April 9, 2004.

Applicants respectfully submit that the evidence convincingly establishes reasonable diligence from a time prior to the effective date of Stern-Berkowitz to the filing date of the present Application. Accordingly, Applicants respectfully maintain that, when coupled with the evidence of conception, the evidence of Applicants' diligence effectively removes Stern-Berkowitz from consideration against Applicants invention and, therefore, each of the claims defines over the prior art.

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CONCLUSION

Applicants believe that this application is now in full condition for allowance. Allowance is therefore respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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